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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/031,198      | 07/02/2002  | Gunter Neef          | SCH 1867            | 2609             |

23599 7590 11/13/2003

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| EXAMINER |
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BADIO, BARBARA P

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| ART UNIT | PAPER NUMBER |
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1616

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/031,198

Applicant(s)

NEEF ET AL.

Examiner

Barbara P. Badio, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 15-23 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 24-26 is/are allowed.
- 6) ☒ Claim(s) 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**First Office Action on the Merits**

***Election/Restrictions***

1. Applicant's election with traverse of Group II in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the Examiner has not established that searching all claims would constitute an undue burden. This is not found persuasive because search of all claims would require a number of different search strategies due to the different invention claimed. Thus, search of all claims would constitute an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Based on applicant's election of Group II, claims 1-11 and 15-23 stand withdrawn from further consideration as being drawn to a nonelected invention. Claims 14, 15 and 24-26 will be examined along with claim 12.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claim recites “[u]se of the compounds of general formula II...”. A use is not patentable under 35 USC 101.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of the instant claims creates confusion as to the claimed invention.

Claim 13 recites but does not identify/define formulae I and Ia. Claim 13 also recites the use of processes that are known in the art analogously to Diagram 2 in the production of compounds of formula II. Although, a claim is interpreted in light of the specification, the general rule is that the claim should be self-contained. That is, it should not expressly rely upon the specification to give it meaning. Ex parte Fressola, 27 USPQ 2d 1609 (BPAI 1993). The instant claim relies on the specification to give meaning to the claimed process. It is suggested that applicant defines formulae I and Ia as well as the process defined by Diagram 2 in the instant claims.

Claim 14 is indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Thus, the skilled artisan would be unable to determine applicant's claimed invention.

***Allowable Subject Matter***

7. Claims 12 and 24-26 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:

The claimed compounds are not taught or suggested by the prior art. The closest prior art compound differs from the claimed compound by the absence of a 9(11) double bond and/or a 5 $\beta$ -substituent as defined by the instant invention (see for example Goldman et al., page 12, paragraph 2, compound III).

***Other Matters***

9. The examiner notes that claims 13 and 14 were combined for examination with applicant's elected Group II in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996).

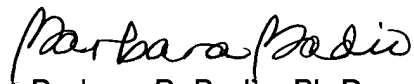
***Telephone Inquiry***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio, Ph.D. whose telephone number is 703-308-4595. The examiner can normally be reached on M-F from 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308- 2927. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Barbara P. Badio, Ph.D.  
Primary Examiner  
Art Unit 1616

BB  
November 12, 2003